

REMARKS

Claims 1, 2 and 4-20 are pending. In the office action that was mailed March 17, 2008, claims 1 and 15 were objected to because of informalities. The Examiner stated that it was unclear what was meant by the word, "selectably." Claim 1 was also objected to because it was unclear what was meant by the word, "theretogether." Claim 1 was objected because the use of the word "for" might make the claim indefinite.

Claims 1-2 and 4-14 were rejected under 35 U.S.C. §101 because the claims were characterized as being directed to an apparatus that may be construed as a *software* apparatus. The Examiner stated that if claims 1-2 and 4-14 positively claimed hardware components that the claims would then be considered statutory subject matter.

Claims 1 and 15 were rejected under 35 U.S.C. §112, ¶1. The Examiner stated that the applicant's amendment to paragraph 0041 cancelled portions of the paragraph that was required to support the last amendment to claims 1 and 15.

Claims 1, 2 and 4-15 were also rejected under 35 U.S.C. §102(e) as being anticipated by Leonetti.

In response to the office action that was mailed March 17th, the claims have been amended to delete the word "selectably." In claim 1, the word "theretogether" has been replaced by the words, -- to each other--. The word "for" has also been deleted where it refers to the function of a device and the claim language revised to affirmatively recite structure. Other superficial and self-explanatory revisions have been made to various claims to improve their readability.

As for the rejections of claims 1 and 15 under §112, paragraph [0041] has been amended to restore the subject matter that was deleted by the applicant's last response. The rejection of claims 1 and 15 under 35 U.S.C. §112 is therefore traversed.

Referring now to the subject matter rejection that was made under 35 U.S.C. §101, the Examiner rejected claims 1 and 4-14 because, he said, "the claims are directed toward an apparatus that may be construed as a software apparatus... thus functional

descriptive material.” (Emphasis added.) It therefore appears that the Examiner rejected claims 1 and 4-14 only because he contends that those claims might be construed to read on software or hardware.

The claim rejections that were made under §101 were improper under well-established Federal Circuit case law and should be withdrawn.

On September 22, 2003, the Court of Appeals for the Federal Circuit published its decision in the case of, Medical Instrumentation and Diagnostics Corp. v. Elekta AB, et al., which is referred to hereafter as “*Elekta*.” At issue in *Elekta* was whether computer software can qualify as the structure required under 35 U.S.C. §112 to support a means-plus-function claim and, whether a means-plus-function claim that is ostensibly supported by software as structure, is valid.

In *Elekta*, the district court ruled that various computer software routines was structure that corresponded to, and performed various functions recited in means-plus-function limitations. The accused infringer disagreed with the district court and sought review by the Federal Circuit.

In its published opinion, the Federal Circuit said that the “[t]he key dispute between the parties [was] whether the district court was correct in including software...as a corresponding structure for [a means-plus-function limitation.]” In *Elekta*, the Federal Circuit reversed the district court and held the claims invalid under §112, but not because the claims were supported by software *per se*. Rather, in its decision, the Court surveyed several precedents and held that patentee MIDCO, did not adequately link the disclosed software as structure that performed the claimed function. The Court said that the district court erred in identifying software as a corresponding structure for the means for performing a claimed function, but only “because the specification and prosecution history [failed] to clearly link or associate software with the performance of the converting function.” Had the patentee in *Elekta* clearly linked software as structure performing claimed function, the claims would have been held valid.

Under *Elekta*, software certainly can qualify as structure supporting a means-plus-function claim, so long as a patent applicant makes it clear in the specification that software is what performs a claimed function. It therefore stands to reason that the hash generator and/or content generator recited in the applicants' claims recite statutory subject matter regardless of whether they are construed to read on software or hardware so long as the applicants' made that equivalence clear in the specification. In this case, the applicants did.

On page 10, lines 3-11 state that, "the apparatus embodied at the mobile node is represented in terms of functional elements...functions... are carried out in any desired manner, such as by algorithms executable by processing circuitry." "In other implementations, the functions... are carried out in other manners." Since the application makes it clear that the claimed functionality is performed by software or hardware, the claim limitations are not invalid under the reasoning set forth in *Elekta* and other decisions of the Federal Circuit described therein.

Referring now to the claim rejections that were made under §102, the Examiner's rejection is based entirely on his belief that a checksum and a hash value are the same things and that the applicant's hash value limitations read on a check sum. The Examiner cited an *extrinsic* reference to construe the term hash value, i.e., the "accuhash" web site, and as ostensibly supporting the Examiner's contention that a checksum and hash value are one and the same thing.

Federal Circuit decisions condemning the use of extrinsic references to construe claims are legion, especially when those references contradict the intrinsic record, as in this case. Putting aside whether it was proper or improper for the Examiner to rely on an extrinsic reference to construe the check sum limitation, the specification and claims have been amended as set forth above so that there can be no ambiguity as to what the applicants mean by, "hash value."

As set forth above, paragraph [0041] has been restored to its original condition. It states that the hash generator computes "check sums as well as more computationally

intensive, hash function computations.” The specification thus makes it clear that the computation of a check sum is different from the computation of a hash value. Check sums are therefore different from hash values.

In response to the office action, the independent claims now recite that the hash values computed by the hash generator are “different from” checksums. Stated another way, a hash value is not a checksum. Since the hash generator is described as generating both check sums and hash values and that the hash values are more computationally intensive, no new matter is added by claiming the hash values to different from check sums.

In view of Examiner’s stated reason for rejecting the claims under §102, and in view of the indisputable facts that Leonetti does not include the word hash, does not disclose a hash value and does not disclose a hash generator, the Examiner has no reason to construe the hash value limitation of claims 1 and 15 as including the checksums disclosed in *Leonetti*. Claims 1 and 15 should therefore be allowed.

The applicant re-asserts all of the arguments for allowance that were made in the last response and respectfully requests reconsideration of the pending claims in view of the above-identified amendment to the specification and to claims 1 and 15. The dependent claims are of course also in condition for allowance.

Respectfully submitted,

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